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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,783	12/30/1999	DONALD K. NEWELL	1020.P6929	2707
57035 7590 KACVINSKY LLC C/O INTELLEVATE P.O. BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER SHANG, ANNAN Q	
			ART UNIT 2623	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			01/24/2007	
			DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/474,783

Applicant(s)

NEWELL ET AL.

Examiner

Annan Q. Shang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9 and 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9 and 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/29/06 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 4-7, 9 and 12-25 have been considered but are moot in view of the new ground(s) of rejection. With respect to claims 1, 4-7, 9 and 12-25 rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Horton et al (4,945,563)** and further in view of **Gotwald (5,987,518)**, applicant amends claims and argues that, "...office action has failed obviousness citing portions of MPEP to support arguments and further argues that the combine teaching of the prior arts of record fail to teach, suggest or disclose the amended claimed limitation, i.e., "...a number of times the playback device may reproduce the received broadcast content."

In response, Examiner disagrees. Examiner notes applicant's arguments, however, Examiner maintains that, the test for obviousness is not whether the features of a secondary reference may be bodily incorporate into the structure of the primary

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reference; nor is it that the claimed invention must be expressly suggested in any one or all the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In this case all reference are in the same field of endeavor, i.e., a TV receiver, which receives and processes TV signals, as such combining the teaching of Russo in view of Horton and further in view of Gotwald would be within the knowledge of one of ordinary skill in the art, and the appropriate motivation was given.

Furthermore it appears Applicant's arguments are directed against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to the amended claim limitations, besides permitting a viewer to view a selected program as many times as desired over a particular time, Russo further teaches other account options, where a user can purchase a predetermined credit in advance or an open-ended line of credit and keeps track of programs that have been selected for output and queries the account database for balance remaining and based on the account information, the storage may not be decompressed or descrambled without further authorization (col.10, line 10-48). Hence the prior arts of record still meet all the claim limitations as discussed below in the office action. This office action is non-final.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-7, 9 and 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Horton et al (4,945,563)** and further in view of **Gotwald (5,987,518)**

With respect to Claim 1, **Russo** teaches a system for controlling use of broadcast content comprising a receiver in communications with a source of broadcast content and a playback device and a storage device, wherein the receiver is configured to extract the descriptor or supplemental information and control the use of the received broadcast content through the playback device and storage device in accordance with descriptor in the received broadcast content (fig.2, col.3 lines 3-28, lines 50-60, col.6 lines 12-25, col.8 lines 55-67). **Russo** teaches where a Storage Device (SD) 14 is coupled to Receiver (R) 4 (fig.1, col. 3 lines 3-20 and lines 40-64).

Furthermore, the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data. **Russo** teaches that descriptor information indicates the storage device may store the received broadcast content prior to viewing and without reproducing the received broadcast content (col.6, lines 34-53, note that SD-14 receives and stores the program and "once the transaction has been registered by the record/play controller, relevant signal de-scrambling facilities

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would be enabled, allowing the program to be viewed") and once stored, a the number of times the received broadcast content may be consumed based on received credit information (col.5 lines 32-46 and col.10, line 10-48), note that besides permitting a viewer to view a selected program as many times as desired over a particular time, Russo further teaches other account options, where a user can purchase a predetermined credit in advance or an open-ended line of credit and keeps track of programs that have been selected for output and queries the account database for balance remaining and based on the account information, the storage may not be decompressed or descrambled without further authorization.

Russo further teaches that the descriptor or supplemental information may in the broadcast content path 102 (col.8 lines 65-67, col.9 line 1), but fails to explicitly state that this control information is embedded in the content and also defines the action or whether to store the received broadcast content prior to viewing.

However, **Horton** teaches broadcasting audiovisual content along with embedded descriptor information to define an action to be taken pertaining to the received content, explicitly storing the received broadcast content (col.3 lines 38-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify Russo with the ability to specify the action as storing the content and embedding descriptor information as in Horton in order for the broadcast provider to specify what could be done to the broadcast programs to prevent unauthorized copying and also allow the user to only access certain programs.

Russo as modified by Horton, teach a receiver comprising a data interface (Russo modem 130, fig.2), but fail to explicitly teach a receiver comprising a data interface having an Internet Protocol (IP) data module to process a broadcast stream comprising IP encapsulated data.

However, note the **Gotwald** reference figures 1 and 2, discloses method and apparatus for communicating Internet protocol data over a broadband MPEG channel and further discloses a receiver (Client 18) comprising a data interface having an Internet Protocol (IP) data module to process a broadcast stream comprising IP encapsulated data (col.3, lines 26-32 and col.3, line 51-col.4, line 7).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Gotwald into the system of Russo as modified by Horton to retrieve additional information from the Internet.

As to claim 4, Russo further teaches that the receiver is configured to maintain information relating to the use of the received broadcast content (col.3 lines 20-25, col.5 lines 48-65).

As to claim 5, Russo teaches that the receiver is configured to use the information relating to the use of the received broadcast content for remuneration of a provider of content (col.4 lines 45-67, col.5 lines 20-33, col.6 lines 34-55).

As to claim 6, Russo teaches that the information relating to the use of the received broadcast content comprises, a duration of use (col.5 lines 32-47).

As to claim 7, the claimed "method comprising..." is composed of the same structural elements that were discussed in the rejection of claim 1.

As to claim 9, Russo teaches lengths of time and days that the broadcast may be viewed (col. 5 lines 33-48), but fails to show that the descriptor information indicates the number of times the received broadcast content may be consumed. Limiting the number of times is a logical variation of the restriction of viewing already set forth by Russo and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made. This would enable the broadcast facility to supply the viewer with various pricing and viewing options.

As to claim 12, Russo teaches that the video can be saved for a predetermined length of time but doesn't specifically state a date range (col. 5, lines 32-46). It is nonetheless inherent that this time period would be more than one day, thus covering a range of dates.

As to claim 13, it is inherent that the information sent to the user site would include billing information (col. 6 lines 10-27).

As to claim 14, it is inherent that the information sent to the user site would contain information for the cost of consuming the broadcast (col. 6 lines 10-27).

As to claim 15, Russo teaches the ability to "unlock" certain viewing options with a code sent along with the video stream (col. 6 lines 10-27). This inherently prevents the unjustified use of the broadcast material since other options would remain locked.

Regarding Claim 16, teaches shows obtaining payment information from the user (col. 6 lines 20-28, lines 35-46, col. 10 lines 10-48).

Regarding Claim 17, teaches shows communicating consumption information to a billing facility (col. 6 lines 34-53, col. 10 lines 10-48).

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Regarding Claim 18, teaches shows that the billing facility comprises a facility maintained by a provider of the broadcast content (col. 6 lines 20-36).

As to claim 19, the claimed "a machine-readable medium... a method comprising..." is composed of the same structural elements that were discussed in the rejection of claim 1.

As to claim 20, Russo further teaches where the storage comprises a memory accessible by a computer.

As to claim 21, Russo fails to show that the storage medium comprises a portable storage device. Official Notice is taken that it is well known and expected in the art to use removable storage devices, such as CD-ROMS or removable hard drives.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify the system of Russo with a portable storage device so that the instructions could be transported to other systems.

As to claims 22-23, the claimed "A system comprising a receiver in communication with a source of broadcast content..." is composed of the same structural elements that were discussed in the rejection of claim 1.

Claim 24 is met as previously discussed with respect to claim 5.

Claim 25 is met as previously discussed with respect to claim 6.

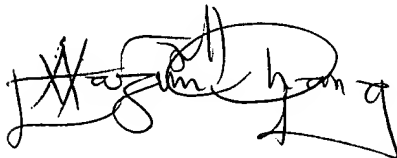
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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', with a stylized flourish at the end.

Annan Q. Shang